REMARKS

I. Claim Rejections - 35 USC §102

Requirements for *Prima Facie* Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

> A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to

grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Parulski et al.

The Examiner rejected claims 22-26, 28 and 36-40 under 35 U.S.C. §102(b) as being anticipated by Parulski et al., (U.S. Patent Application No. 2007/0067295), hereinafter referred to as "Parulski".

Regarding claim 22, the Examiner argued that Parulski discloses a method of maintaining a user searchable digital image database, wherein said digital image database contains a plurality of digital images (citing abstract); displaying via a display screen at least one thumbnail image representing at least one digital image of said plurality of digital images within a frame in response to a search for a digital image by said user (citing page 5, paragraph [0049]); embedding within said frame a plurality of iconettes representing a plurality of user selectable functions associated with said at least one digital image (citing page 5, paragraph [0049]).

The Applicant respectfully disagrees with this assessment and notes that claim 22 includes the following limitations: 1) at least one thumbnail image representing at least one digital image of said plurality of digital images within a *frame* in response to a search for a digital image by said user; and 2) *embedding* within said frame a *plurality* of iconettes representing a *plurality* of user selectable functions associated with said at least one digital image. Prior art, in order to anticipate claim 22 under 35 U.S.C. §102, must disclose these limitations of at least one digital thumbnail image *within a frame* and a plurality of iconettes *embedded within* the frame representing a plurality of user selectable functions *in response* to a search for a digital image. Parulski, page 5, paragraph [0049], is disclosing *search methods* of an image database and is not disclosing the limitations of the Applicant's claim 22.

The Examiner's citation of Parulski, paragraph [0049], is a description of these search methods. Paragraph [0049] refers to Parulski, FIG. 7, which is a

graphical depiction of the results of the search method disclosed. Parulski, FIG. 7, discloses the search parameters utilized in the search of the database but does not disclose 1) a plurality of iconettes 2) representing a plurality of user selectable functions 3) embedded within the frame.

Parulski discloses search methods and a function associated with a search but does not disclose the Applicant's claimed invention of claim 22. Parulski does not disclose *any* functions selectable by the user once the search is completed (i.e. "in response to a search"); only disclosing functions to *perform* the search. The Applicant's invention is a method *in response* to a search and not a search method itself. *In response* to a search the thumbnail images are displayed within a frame which includes iconettes embedded *within* the frame. The iconettes represent additional functions which are selectable by the user. Each thumbnail is enclosed within a frame such that each thumbnail includes individual iconettes. This is disclosed in the Applicant's paragraph [0039] as follows:

> "In general, a user interface (e.g., GUI) for viewing images presented in image and text format can be enhanced by the creation of objects such as iconettes 402 or "hot areas" embedded within individual image frames or borders."
> "When a user retrieves a thumbnail image or a set of thumbnail images as the result of a search or other data-processing system event initiated by the user, such images can be displayed in a visible "thumbnail" frame. Small color-coded icons or "iconettes" can then be displayed in the space between the edge of the thumbnails and the outer edge of the frame." (emphasis added)

The Applicant has amended claim 22 to clarify the limitation of an individual frame with the additional limitation wherein each thumbnail image is displayed within an individual frame. This is disclosed in the Applicant's paragraph [0039]. Therefore each thumbnail image has associated iconettes representing a plurality of user selectable functions associated with each image. Parulski does not disclose this limitation.

Therefore, Parulski fails to disclose: 1) displaying at least one thumbnail image within an individual frame; 2) in response to a search for a digital image; 3)

embedding within said individual frame a plurality of iconettes; or 4) representing a plurality of user selectable functions.

Parulski therefore fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claim 22 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(b) rejections of claim 22 based on the Parulski reference be withdrawn.

Regarding claim 23, the Examiner argued that Parulski discloses a method of claim 22 further comprising: displaying information relevant to said at least one digital image in a form of a graphical pop-up window by rolling a graphically displayed cursor over said at least one iconette (citing page 4, paragraph [0049]; page 5, paragraph [0048]). The Examiner argued that here the user selects the show label icon and information about the image is displayed, additionally a metadata icon is provided and once the image is selected the information is provided in a window.

Regarding claim 24, the Examiner argued that Parulski discloses a method of claim 22 further comprising: displaying an iconette information window comprising an interactive region for initiating at least one user transaction thereof by clicking said at least one iconette (citing page 5, paragraph [0049]).

Regarding claim 25, the Examiner argued that Parulski discloses a method of claim 22 wherein said digital image database is searchable by said user by subject of said digital image (citing page 5, paragraph [0049]).

Regarding claim 26, the Examiner argued that Parulski discloses a method of claim 22 wherein each iconette of said plurality of iconettes displays represents a different function for displaying different categories of information relevant to said digital image (citing page 5, paragraph [0049]).

Regarding claim 28, the Examiner argued that Parulski discloses a method of claim 22 wherein said user searchable digital image database is searchable by at least one of the following: a digital image subject, a photographer name, a date of digital image or location (citing page 5, paragraph [0049]).

The Applicant respectfully disagrees with these assessments and notes that the argument presented above against the rejection of claim 22 applies equally against the rejections of dependent claims 23-26 and 28. As submitted above, Parulski fails to disclose: 1) displaying at least one thumbnail image within an individual frame; 2) in response to a search for a digital image; 3) embedding within said individual frame a plurality of iconettes; or 4) representing a plurality of user selectable functions.

Parulski therefore fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claim 23-26 and 28 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(b) rejections of claims 23-26 and 28 based on the Parulski reference be withdrawn.

Regarding claim 36, the Examiner stated that it is similar in scope to claim 22 and therefore rejected under the same rationale.

Regarding claim 37, the Examiner stated that it is similar in scope to claim 23 and therefore rejected under the same rationale.

Regarding claim 38, the Examiner stated that it is similar in scope to claim 24 and is therefore rejected under the same rationale.

Regarding claim 39, the Examiner stated that it is similar in scope to claim 28 and is therefore rejected under the same rationale.

Regarding claim 40, the Examiner stated that it is similar in scope to claim 26 and is therefore rejected under the same rationale.

The Applicant respectfully disagrees with these assessments and notes that the argument presented above against the rejection of claim 22 applies equally against the rejections of claims 36-40 as the Applicant notes that claim 36 has been amended similarly to claim 22 wherein each thumbnail image is displayed within an individual frame.

Parulski therefore fails in the aforementioned *prima facie* anticipation test as each and every limitation of the Applicant's claim 36-40 is not disclosed. Based on

the foregoing, the Applicant respectfully requests that the 35 U.S.C. §102(b) rejections of claims 36-40 based on the Parulski reference be withdrawn.

II. Claim Rejections - 35 USC § 103

Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

> "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

> "The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."
>
> "To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and

2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and

of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Parulski et al. in view of Willner et al./Davis et al.

The Examiner rejected claims 27 and 41 under 35 U.S.C. §103(a) as being unpatentable over Parulski in view of Willner et al, (U.S. Patent No. 7,149,370), hereinafter referred to as "Willner" and Davis et al., (U.S. Patent No. 7010144), hereinafter referred to as "Davis".

Regarding claim 27, the Examiner argued that Parulski discloses a method of claim 26 but admitted Parulski does not explicitly disclose wherein said different categories of information relevant to said digital image includes copyright data and data indicative of at least one of the following: file size, file format, royalties, file permissions and conditions of use. The Examiner argued that however, Willner discloses a method and device for image surfing and discloses providing additional information about the image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that additionally, Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis col. 10, lines 24-29 and 50-51; col. 11, lines 8-10).

The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as additional metadata to be provided in Parulski as taught by Willner and Davis. The Examiner argued that one would have been motivated to provide file information to inform the user of specific details which can enhance user's search capabilities, and additionally providing more detailed levels in Parulksi.

Regarding claim 41, the Examiner stated that it is similar in scope to claim 27 and therefore rejected under the same rationale.

The Applicant respectfully disagrees with this assessment and notes that the arguments presented above against the rejections of claims 22 and 36 applies equally against the rejections of dependent claims 27 and 41. As submitted above, Parulski fails to disclose: 1) displaying at least one thumbnail image within an individual frame; 2) in response to a search for a digital image; 3) embedding within said individual frame a plurality of iconettes; or 4) representing a plurality of user selectable functions. Willner and Davis do not disclose these limitations.

The Applicant further submits that as Parulski discloses only search methods and the display of the search results and does not disclose functions which are performed on the search results via the iconettes, it would not be obvious to modify Parulski in view of Willner and Davis to the invention of the Applicant.

Parulski in view of Willner and Davis therefore fails in the aforementioned *prima facie* obviousness test as each an ever limitation of the Applicant's claims 27 and 41 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 27 and 41 based on Paruski in view of Willner and Davis be withdrawn.

Parulski et al. in view of Komar et al.

The Examiner rejected claims 29-33 and 35 under 35 U.S.C. §103(a) as being unpatentable over Parulski in view of Komar et al., (U.S. Patent Application 2007/0079224), hereinafter referred to as "Komar".

Regarding claim 29, the Examiner argued that Parulski discloses a method comprising: maintaining a user searchable digital image database wherein said digital image database contains a plurality of digital images (citing abstract); displaying via a display screen at least one thumbnail image representing at least one digital image of said plurality of digital images within a frame in response to a search for a digital image by said user (citing Parulski page 5, paragraph [0049]); embedding within said frame a plurality of iconettes representing a plurality of user

selectable functions associated with said at least one digital image; and selecting at least one iconette of said plurality of iconettes to thereby display information relevant to said at least one digital image (citing Parulski page 5, paragraph [0049]).

The Examiner admitted that however Parulski does not explicitly disclose color-coded iconettes. The Examiner argued that however Komar has been provided because he discloses an image with selectable areas and icons around the image which can be color based (citing Komar page 2, paragraph [0020]; page 4, paragraph [0031]). The Examiner argued that therefore it would have been obvious to provide the color code functionality with the icons of Parulski as taught by Komar. The Examiner argued that one would have been motivated to provide the color code functionality in order to present multiple visual options (citing color/text) to user in order to distinguish selections.

Regarding claim 30, the Examiner argued that Parulski and Komar disclose a method of claim 29 further comprising: displaying information relevant to said at least one digital image in a form of a graphical pop-up window by rolling a graphically displayed cursor over said at least one iconette (citing Parulski page 4, paragraph [0046]; page 5, paragraph [0048]). The Examiner argued that here the user selects the show label icon and information about the image is displayed, additionally a metadata icon is provided and once the image is selected the information is provided in a window.

Regarding claim 31, the Examiner argued that Parulski and Komar disclose a method of claim 29 further comprising: displaying an iconette information window comprising an interactive region for initiating at least one user transaction thereof by clicking said at least one iconette (citing Parulski page 5, paragraph [0049]).

Regarding claim 32, the Examiner argued that Parulski and Komar disclose a method of claim 29 wherein said digital image database is searchable by said user by subject of said digital image (citing Parulski page 5, paragraph 0049]).

Regarding claim 33, the Examiner argued that Parulski and Komar disclose a method of claim 29 wherein each iconette of said plurality of color-coded iconettes displays represents a different function for displaying different categories of information relevant to said digital image (citing Parulski page 5, paragraph [0049]).

Regarding claim 35, the Examiner argued that Parulski and Komar disclose a method of claim 29 wherein said at least one thumbnail image representing at least one digital image (citing Parulski page 5, paragraph [0049]).

The Applicant respectfully disagrees with these assessments and notes that the argument presented above against the rejection of claim 22 applies equally against the rejections of claims 29-33 and 35 as the Applicant notes that claim 29 has been amended similarly to claim 22 wherein each thumbnail image is displayed within an individual frame.

Additionally, Parulski in view of Komar fails to disclose: 1) displaying at least one thumbnail image within an individual frame; 2) in response to a search for a digital image; 3) embedding within said individual frame a plurality of iconettes; or 4) representing a plurality of user selectable functions.

Parulski in view of Komar therefore fails in the aforementioned *prima facie* obviousness test as each an ever limitation of the Applicant's claims 29-33 and 35 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 29-33 and 35 based on Paruski in view of Komar be withdrawn.

Parulski et al. in view of Komar et al./Willner et al./Davis et al.

The Examiner rejected claim 34 under 35 U.S.C. §103(a) as being unpatentable over Parulski and Komar in further view of Willner and Davis.

Regarding claim 34, the Examiner argued that Parulski and Komar disclose a method of claim 29 but admitted do not explicitly disclose wherein said different

categories of information relevant to said digital image includes conditions of use and at least one of the following: file size, file format, royalties, file permissions and copyrights. The Examiner argued that however Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that additionally, Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis column 10, lines 24-29 and 50-51; col. 11, lines 8-10).

The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as additional metadata to be provided in Parulski as taught by Willner and Davis. The Examiner argued that one would have been motivated to provide file information to inform the user of specific details which can enhance user's search capabilities, and additionally providing more detailed levels in Parulski.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of claim 29 applies equally against the rejections of claims 34. Parulski in view of Komar, Willner and Davis fails to disclose: 1) displaying at least one thumbnail image within an individual frame; 2) in response to a search for a digital image; 3) embedding within said individual frame a plurality of iconettes; or 4) representing a plurality of user selectable functions.

Parulski in view of Komar, Willner and Davis therefore fails in the aforementioned *prima facie* obviousness test as each an ever limitation of the Applicant's claim 34 is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 34 based on Paruski in view of Komar, Willner and Davis be withdrawn.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §102 and §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: February 12, 2010

William Shelby
Agent for Applicants
Registration No. 57,305
ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484
Tel. 505-314-1312